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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,190	03/29/2001	Martin A. Kenner	56096US002	4518

32692 7590 11/30/2004

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EXAMINER

OSMAN, RAMY M

ART UNIT PAPER NUMBER

2157

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,190

Applicant(s)

KENNER ET AL.

Examiner

Ramy M Osman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ↓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to amendment filed on 8/19/2004. Claims 1-42 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 5 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant states that the method “is performed without identifying the content recipient to the content provider”. The specification merely repeats this language on page 29 lines 5-10, and fails to further explain how a client can request something without identifying itself. A client request inherently involves some sort of identification (like email or IP address). To anonymize this identification, a method or protocol is necessary to accomplish it. Applicant fails to detail this feature.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 15 and 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant fails to provide a distinction between “burn through the session” and “display in front of session”. They will be treated in like manner.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1,2-4,6-13,17-22,26,28-34,36,37 and 40-42 rejected under 35 U.S.C. 102(e) as being anticipated by over Chiles (US Patent No 6,167,567).**

8. In reference to claims 1,18 and 32, Chiles teaches a method performed at a content recipient, and a computer readable storage comprising:

executing first program code at the content recipient so as to identify a content provider having posted content of interest to the content recipient (column 3 line 35 – column 4 line 15 and column 4 lines 30-40, Chiles discloses a client identifying and accessing a software provider); and

executing second program code at the content recipient so as to automatically initiate a request for the posted content (Abstract and column 4 lines 30-65, Chiles discloses automatically requesting software update).

9. In reference to claim 2, 4,6,8 and 33, Chiles teaches the method and computer readable storage of claims 1 and 32 further comprising canceling future requests for the posted content without communicating such an intent with the content provider (column 16 lines 15-40, Chiles discloses canceling update request).

10. In reference to claim 3,7,26,28 and 34, Chiles teaches the method and computer readable storage of claims 1,18 and 32 wherein the executing of the second program code at the content recipient so as to automatically initiate a request for the posted content comprises executing second program code at the content recipient so as to automatically and recurrently initiate requests for the posted content (column 3 lines 40 & 41, Chiles discloses automatically and periodically requesting updates).

11. In reference to claims 9 and 29, Chiles teaches the method and computer readable storage of claims 1 and 18 further comprising executing third program code at the content recipient so as provide notice to the recipient that no posted content has been received by the content recipient in response execution of the second program code (column 9 lines 45-60, column 14 lines 10-15, column 15 lines 5-11 and figures 5A-5D, Chiles discloses notification to client regarding status of update).

12. In reference to claims 10,12,19,20,21,30,31 and 36, Chiles teaches the method and computer readable storage of claims 1,18 and 32 further comprising executing third program code at the content recipient so as to receive the posted content at the content recipient in

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response to execution of the second program code (column 8 lines 30-65, Chiles discloses receiving update).

13. In reference to claims 11,13,22 and 37, Chiles teaches the method and computer readable storage of claims 12,18 and 36 further comprising executing fourth program code at the content recipient so as to provide notice to the content recipient that the posted content has been received at the content recipient in response to execution of the second and third program code, wherein the notice is displayed even if the session is active (column 15 lines 1-60 and figures 5A-5D, Chiles discloses notification to client regarding status of update).

14. In reference to claims 17,41 and 42, Chiles teaches the method and computer readable storage of claims 1 and 32 further comprising electronically receiving the second program code at the content recipient from the content provider (Abstract).

15. In reference to claim 40, Chiles teaches the method of claim 32 further comprising executing third program code at the content provider so as to determine whether the content recipient possesses the second program code and, if the content recipient does not possess the second program code, to download the second program code to the content recipient (column 4 lines 5-65).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 5,27 and 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Chiles (US Patent No 6,167,567) in view of Kenner et al (US Patent No 6,314,565).

Chiles teaches the method and computer readable storage of claims 1,18 and 32 above. Chiles teaches FTP request for software update (column 4 lines 30-45). Chiles fails to explicitly teach wherein the method is performed without identifying the content recipient to the content provider. However, Kenner teaches a client anonymously requesting content (using Anonymous FTP) from a content provider to allow client access without identifying the client (Summary and column 10 lines 40-67).

It would have been obvious for one of ordinary skill in the art to modify Chiles by not identifying the client when the client requests content from a provider as per the teachings of Kenner so as to allow client access without identifying the client.

18. Claims 14 and 23 and rejected under 35 U.S.C. 103(a) as being unpatentable over Chiles (US Patent No 6,167,567) in view of Mohammed (US Patent No 6,418,555).

Chiles teaches the method and computer readable storage of claims 13 and 22 above. Chiles fails to explicitly teach wherein the notice is an icon. However, Mohammed teaches an update module prompting the user after update is complete for the purpose of restarting the computer so the update can take effect (column 5 lines 25-50).

It would have been obvious for one of ordinary skill in the art to modify Chiles by making the notice an icon/prompt as per the teachings of Mohammed complete for the purpose of restarting the computer so the update can take effect.

19. Claims 15,16,24,25,38 and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Chiles (US Patent No 6,327,617) in view of Slotznick (US Patent No 6,011,537).

Chiles teaches the method and computer readable storage of claims 13 and 37 above. Chiles fails to explicitly teach wherein the method further comprises executing fifth program code at the content recipient so that, upon an action related to the notice, the posted content burns through the session so that the posted content is visible to a user; and comprises executing fifth program code at the content recipient so that, upon an action related to the notice, the posted content is displayed in front of the session so that the posted content is visible to a user. However, Slotznick teaches displaying or otherwise bringing content to the front when a certain action occurs (column 15 lines 1-45).

It would have been obvious for one of ordinary skill in the art to modify Chiles by bringing content to the front when a certain action occurs as per the teachings of Slotznick so that that particular content can be prioritized and displayed to the user.

Response to Amendment

20. Examiner acknowledges amendment filed on 8/19/2004 where applicant amended claims 2,4,6,8,24,25 and 31-33.

Response to Arguments

21. Applicant's arguments with respect to claims 1-42 have been considered but are moot in view of the new ground(s) of rejection.

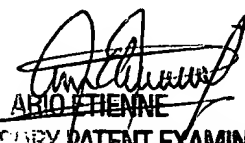
22. Applicant's arguments regarding claims 5,27 and 35 have been fully considered but they are not persuasive. On page 31 of applicants response, applicant points out that anonymous FTP can usually send a request with the users email as the password. Official Notice is taken that Anonymous FTP is well known in the art and that anything can be used for the password, and not necessarily the users email.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMO
November 19, 2004


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